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EXAMINER
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3651	

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/083,422

Applicant(s)  
Clare et al.

Examiner  
Andrew C. Pike

Group Art Unit  
3651



☒ Responsive to communication(s) filed on Jan 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5, 7, 10-12, 14, 24-28, and 30-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5, 7, 10-12, 14, 24-28, and 30-48 is/are rejected.

☒ Claim(s) 24-28, 30-34, 38, 44, 47, and 48 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 22, 1998 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Sep 21, 1998 is ☒ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Priority**

1. Applicants' claim for priority for receiving the benefit under 35 U.S.C. § 120 is objected to as being inconsistent.

Applicants explicitly claim priority in the oath or declaration filed May 22, 1998, for receiving the benefit under 35 U.S.C. § 120 of only the earlier filing date of noncopending U.S. patent application Serial No. 08/685,678 filed July 24, 1996, of which copending U.S. patent application No. 08/910,516 is a continuation-in-part, the present application Serial No. 09/083,422 being referred to as a continuation of No. 08/910,516.

However, Applicants have included specific references to No. 08/910,516 and No. 08/685,678 and also U.S. patent application Serial No. 08/506,893 filed July 26, 1995, of which No. 08/685,678 is a continuation-in-part, in the present application Serial No. 09/083,422 as the first sentence of the specification thereof, thus implicitly claiming priority under 35 U.S.C. § 120 by complying with the requirements thereof ("An application ... shall have the same effect ... as though filed on the date of the prior application, if ... it contains or is amended to contain a specific reference to the earlier filed application.").

This is inconsistent, in that it is unclear as to which priority claim Applicants are in fact relying upon, and thus which, or all, earlier filing dates Applicants claim for receiving the benefit thereof.

Correction is required for the claim for priority under 35 U.S.C. § 120. Alternatively, Applicants may disclaim priority under 35 U.S.C. § 120 to applications Serial Nos. 08/506,893 and 08/685,678 and 08/910,516, or Nos. 08/506,893 and 08/685,678, or No. 08/506,893, by filing a statement disclaiming the benefit under 35 U.S.C. § 120 of the earlier filing dates thereof, by filing an amendment canceling the specific references thereto in the first sentence of the specification of the present application, and by submitting a supplemental oath or declaration which does not include a claim for priority thereto.

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***Oath/Declaration***

2. Receipt of the supplemental oath or declaration filed January 8, 1999, is acknowledged. It fails to be directed toward the present application Serial No. 09/083,422 (it instead identifies No. 08/910,516 as the application to which it is directed), and thus is not acceptable.

***Claim Rejections - 35 U.S.C. § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 44 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following is new matter which has been introduced into the claims: claim 44, line 3, "sideways".

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 35-48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The following lack clear antecedent basis: claim 35: line 5, "said conventional bed" (which: the "conventional bed" of claim 35, line 2, the "conventional bed" of claim 35, line 4, or some other "conventional bed"? deletion of "conventional" in claim 35, line 4, is suggested); claim 36: line 1, "said bed" (insertion of "conventional" after "said" in claim 36, line 1, is suggested); claim 37: line 2, "said bed"; claim 38: line 2, "said bed"; claim 43: lines 8-9, "said at least one hinged contoured side panel" (insertion of "section" after "panel" in claim 43, line 9, is suggested).

#### ***Claim Objections***

7. Claims 24-28, 30-34, 38, 44, 47, and 48 are objected to because of the following informalities:

The comma in claim 24, line 3, should be deleted. Lines 6-7 of claim 38 are grammatically awkwardly worded. There should be a comma after "downwardly" in claim 44, line 3.

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The following are initial recitations which are not so recited, or are subsequent recitations which are not uniquely and/or consistently recited: claim 25: lines 11-12, "said at least one hinged section" (the word "a" in claim 25, line 8, should be "one"); claim 47: line 2, "hinged contoured side panel section" (it should be "said hinged contoured side panel section"); line 3, "a storage box" (it should be "one said storage box"); line 3, "an interior"; line 4, "an opening"; line 5, "a lock/latch mechanism"; claim 48: line 5, "hinged contoured side panel section".

Appropriate correction is required.

#### ***Claim Rejections - Double Patenting***

8. Claims 11 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 5,823,598.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the mere variation of non-patentably distinct features in the claims.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

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*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

#### ***Claim Rejections - 35 U.S.C. § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5, 43, and 44 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by McCready.

#### ***Claim Rejections - 35 U.S.C. § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

13. Claims 7, and 47 as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over McCready.

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McCready clearly discloses a vehicle having contoured side panels, and a hidden storage system mounted adjacent one side panel including, *inter alia*, a storage box, a section 32 of the adjacent contoured side panel being horizontally hinged, and a hidden lock/latch mechanism, wherein an external appearance of the adjacent contoured side panel is not substantially altered. Have one hidden storage system on each side would merely be a duplication thereof entailing no more than routine skill in the art, and thus would have been obvious to one of ordinary skill in the art at the time the invention was made.

14. Claims 1, 4, 5, 7, and 25-28, and 43 and 47 as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith.

Stiles clearly discloses almost all of the claimed features of the hidden storage system for a vehicle having side panels which does not substantially alter an external appearance of the vehicle (see Fig. 1), including *inter alia* a storage box including a compartment, and an opening to expose an interior thereof, mounted on each side of the vehicle (page 2, column 2, lines 8-15), each box partially covering over and rearwardly a wheel well, one section 22 of one of the side panels on each side of the vehicle being hinged (page 2, column 2, line 9) to be opened and closed to expose and cover the interior of each box to



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provide the only access thereto, and naturally latch mechanisms to releasably secure each hinged section hidden behind the hinged section thereof; but lacks lock means for actuating the latch mechanism on each side.

Smith clearly discloses (column 1, lines 11-30), as conventional in the art, a storage system for a vehicle having rear panels which does not substantially alter an external appearance of the vehicle, including a storage box including a compartment mounted in the rear side of the vehicle covering wheel wells, one section of one of the rear panels being hinged to be opened and closed to expose and cover an interior of the box, a latch mechanism to releasably secure the hinged section hidden behind the hinged section, and lock means for actuating the latch mechanism hidden behind an escutcheon and decorative cover.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the vehicle of Stiles to include lock means, as taught by Smith, because lock means for actuating latch mechanism, wherein the latch mechanism and the lock means are hidden from view with the external appearance of the vehicle being not substantially altered, is conventional in the art (Smith, column 1, lines 13-15).

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15. Claims 2, 3, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claims 1 and 25 above, and further in view of Sisler.

Stiles further lacks that each storage box extends forward and over the wheel well thereof along a section of the vehicle floor.

Sisler discloses a hidden storage system, for a vehicle having side panels and a floor, wherein the hidden storage system does not substantially alter the external appearance of the vehicle and comprises a storage box (column 3, lines 36-37) mounted on each side of the enclosure of the vehicle extending along a section of the vehicle floor and having at least one compartment, each box covering over a wheel well forwardly and rearwardly and having a height less than that of the side panels and being hidden with the external vehicle appearance not being substantially altered.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to have each storage box extend over the wheel well thereof along a section of the vehicle floor, as taught by Sisler, to use effectively the spaces over the wheel wells (Sisler, column 1, lines 15-17 and 22-24, and Figs. 1 and 2).

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16. Claims 10, 12, 24, and 30, and 44 as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claims 1, 25, and 43 above, and further in view of Ogilvie, 1966.

Stiles further lacks a strut assembly, an, e.g., adjustable, shelf, a plurality of hinged sections for each box.

Ogilvie, 1966, discloses a storage system, for a vehicle having side panels, wherein the storage system comprises a storage box mounted on each side of the vehicle covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being hinged for outward movement to open positions, a strut assembly 110, and an adjustable shelf 86.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to include a strut assembly, an, e.g., adjustable, shelf, and a plurality of hinged sections for each box, as taught by Ogilvie, 1966, because the hinged side panel sections and strut assembly would provide side access to the interior of the storage boxes (Ogilvie, 1966, Fig. 3), the location of the adjustable shelf being selectable as desired (Ogilvie, 1966, column 3, lines 33-35).

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17. Claims 14, 30, and 34, and 46 as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claims 1, 25, and 43 above, and further in view of LeVee.

Stiles further lacks a drain/air relief valve assembly in a bottom area of each box, and a plurality of horizontally hinged sections for each box.

LeVee discloses a storage system, for a vehicle having side panels, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle covering over a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being horizontally hinged for outward movement to open positions, and drain/air relief valve assemblies 60 in a bottom area of the boxes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to include a drain/air relief valve assembly in a bottom area of each box, and a plurality of horizontally hinged sections for each box, as taught by LeVee, because the hinged side panel sections would provide side access to the interior of the storage box (LeVee, Fig. 2)

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and the drain/air relief valve assemblies would prevent moisture condensation (LeVee, column 4, lines 15-17).

18. Claims 31-33, as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claim 25 above, and further in view of LeVee and Sisler.

Stiles further lacks that the hinged section is located entirely above the wheel well, extending forwardly, rearwardly, and over.

Paragraph 17 above is incorporated by reference as to LeVee.

Paragraph 15 above is incorporated by reference as to Sisler.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to have the hinged section located entirely above the wheel well, extending forwardly, rearwardly, and over, as taught and suggested by LeVee and Sisler, to provide side access to the interior of the storage boxes (LeVee, Fig. 2) and to use effectively the spaces over the wheel wells (Sisler, column 1, lines 15-17 and 22-24, and Figs. 1 and 2).

19. Claims 1-5, 7, 10, 12, 24-28, and 30-33, and 35-41, 43, 44, 47, and 48 as understood, are rejected under 35 U.S.C. § 103(a)

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as being unpatentable over Sisler in view of Stiles and Ogilvie, 1966.

Sisler discloses a hidden storage system, for a vehicle including *inter alia* contoured side panels, a driver's side door, a cab, at least one rear door, and an enclosure including a pickup bed for equipment having floor, bulkhead, contoured side panel, and tailgate sections, the tailgate section including a tailgate comprising the rear door, wherein the hidden storage system does not substantially alter the external appearance of the vehicle and comprises *inter alia* a storage box (column 3, lines 36-37) mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a section of the vehicle floor and having at least one compartment, each box covering over a wheel well forwardly and rearwardly and having a height less than that of the side panels and being hidden with the external vehicle appearance not being substantially altered; but lacks, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions to provide the only access thereto, a hidden latch mechanism, lock means, a strut assembly, and an, e.g., adjustable, shelf.

Stiles discloses a hidden storage system, for a vehicle, comprising a storage compartment mounted on each side of the vehicle (page 2, column 2, lines 8-15), each compartment

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partially covering over and rearwardly a wheel well and wherein a portion 22 of a contoured side panel of the vehicle is hinged (page 2, column 2, line 9) to provide the only access thereto, with the compartment being hidden with the external appearance of the vehicle not being substantially altered.

Ogilvie, 1966, clearly discloses a storage system, for a vehicle having side panels, a driver's side door, a cab, at least one rear door, and an enclosure including a pickup bed for equipment having floor, bulkhead, side panel, and tailgate sections, the tailgate section including a tailgate comprising the rear door, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a floor thereof and covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being hinged for outward movement to open positions to provide the only access thereto, and having a hidden latch mechanism, including hidden latch members hidden behind the hinged sections, mechanically activated lock means, compartments and adjustable shelves 86, and a strut assembly 110.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each box, sections of one of the enclosure

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side panels being hinged for outward movement to open positions to provide the only access thereto, a hidden latch mechanism, lock means, a strut assembly, and an, e.g., adjustable, shelf, as suggested and taught by Stiles and Ogilvie, 1966, because the hinged side panel sections and strut assembly would provide side access to the interior of the storage box (Ogilvie, 1966, Fig. 3; Stiles, page 2, column 2, lines 8-15) without substantially altered the external appearance (Sisler, column 1, lines 43-45; Stiles, Fig. 1), the location of the adjustable shelf being selectable as desired (Ogilvie, 1966, column 3, lines 33-35).

20. Claims 1-3, 5, 7, 12, 14, 24-28, 30-32, and 34, and 35-39, 42-44, and 46-48 as understood are rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Sisler in view of Stiles and LeVee.

Sisler discloses a hidden storage system (see paragraph 19 above), but lacks, for each box, sections of one of the enclosure side panels being horizontally hinged for outward movement to open positions to provide the only access thereto, a latch mechanism, lock means, and a drain/air relief valve assembly.

Paragraph 19 above is incorporated by reference as to Stiles.

LeVee clearly discloses a storage system, for a vehicle having contoured side panels, a driver's side door, a cab, at



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least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, the tailgate section including a tailgate comprising the rear door, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a floor thereof and covering over a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a contoured side panel of the vehicle enclosure being horizontally hinged for outward movement to open positions to provide the only access thereto, and having a latch mechanism, mechanically activated lock means, shelves and compartments, and drain/air relief valve assemblies 60 in a bottom area of the boxes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each box, sections of one of the enclosure side panels being horizontally hinged for outward movement to open positions to provide the only access thereto, a latch mechanism, lock means, and drain/air relief valve assembly, as suggested and taught by Stiles and LeVee, because the hinged side panel sections would provide side access to the interior of the storage box (LeVee, Fig. 2; Stiles, page 2, column 2, lines 8-15) without substantially altered the external appearance (Sisler, column 1, lines 43-45; Stiles, Fig. 1), with the drain/air relief

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valve assemblies preventing moisture condensation (LeVee, column 4, lines 15-17).

***Specification***

21. The specification is objected to under 37 C.F.R. § 1.74 as failing to correctly identify the different parts shown in the figures by unique reference numerals required by 37 C.F.R.

§ 1.84(p)(4):

Reference numerals 103 and 104 each improperly identifies more than one feature (e.g., 103 on page 16, lines 4 and 6, should be 103' and 104 on page 16, line 6, should be 104', 103 on page 16, line 27, should be 303 and 104 on page 16, line 27, should be 304, etc.). The description of the modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The description of the alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The description of the alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment.

Appropriate correction is required.

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***Drawings***

22. The proposed drawing correction filed on September 21, 1998, has been approved.

23. The drawings are objected to under 37 C.F.R. § 1.84(p)(4) as failing to uniquely and correctly identify reference numerals:

Reference numerals 103 and 104 each improperly labels more than one feature (e.g., 103 and 104 in Fig. 10 should be 103' and 104', etc.). The modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment (i.e., 150, etc., in Fig. 16 indicates that the assembly shown therein is the same assembly as shown in Fig. 15, while page 22 of the specification describes it as a different assembly).

Correction is required.

24. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "bulkhead section" (claim 28, line 2; this is not shown in any of Figs. 5-7); and "sideways" (claim 44,

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line 3) must be shown or the features canceled from the claims.

No new matter should be entered.

25. Applicants are required to submit a Proposed Drawing Correction in response to this Office Action, if the objection to the drawings is not otherwise overcome. Any proposal for amendment by the Applicants of the drawings to cure defects must include either:

- (a) a sketch in permanent black ink in compliance with 37 C.F.R. § 1.121(a)(3), showing
  - (1) the originally filed drawings with changes in red ink, or
  - (2) Proposed Substitute Drawings or Proposed Additional Drawings in black ink; or
- (b) new drawings in compliance with 37 C.F.R. § 1.84, including
  - (1) a sketch in permanent black ink showing the originally filed drawings with changes thereto in red ink in compliance with 37 C.F.R. § 1.121(a)(3)(ii), and
  - (2) new formal drawings correcting the noted defects.

This proposal should be a separate letter, i.e., drawings with a cover letter with an appropriate heading, e.g., "Proposed Drawing Correction", in compliance with 37 C.F.R. §§ 1.4(c) and 1.121(a)(3)(ii).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defects may be deferred until the application is allowed by the Examiner, but the sketch in permanent ink of the Proposed Drawing Correction is required in response to this Office Action, and may not be deferred unless the objection to the drawings is otherwise overcome.

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***Response to Amendment***

26. The following amendments filed January 8, 1999, to the claims fail to comply with 37 C.F.R. § 1.121(a)(2)(ii):

deletion of the words "hinged, whereby outward or inward movement of said" without being bracketed in amended claim 38, line 6.

To expedite prosecution on the application, the noted amendments will be acted upon as if the noted insertions and/or deletions were in fact respectively underlined and bracketed.

***Response to Arguments***

27. Applicants' arguments filed January 8, 1999, have been fully considered but they are not persuasive.

Applicants repeatedly reference "MPEP 608.02(p)(4)", i.e., section 608.02(p)(4) of the Manual of Patent Examining Procedure. However, the Manual does not have any section 608.02(p)(4); see enclosed copy of page 600-93 of the seventh edition, dated July 1998, of the Manual of Patent Examining Procedure, showing (relative to a subsection "(p)") only "608.02(p) Correction of Drawings".

For the rejections of claims 11 and 45 over patented claim 18, the differences therebetween fail to patentably

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distinguish; see paragraphs 10 et seq. above setting forth rejections for lack of patentably distinguishing features.

Stiles clearly discloses a vehicle having side panels and including a hidden storage system which does not substantially alter an external appearance of the vehicle; see Fig. 1 wherein the panel section 22 is shown in the closed position, and thus clearly discloses that the hinging and the latch mechanism for the hinged panel section 22 are hidden and not visible. The hinged panel section 22 of Stiles naturally includes a latching mechanism; otherwise, the hinged panel section 22 would swing back and forth unrestrained as the vehicle is being driven about. As to the lock (or the combination of a hinge, a latch, and a lock) being "hidden", this is conventional in the art as taught by Smith, e.g., a conventional storage system such as a trunk. When the hinged panel section, e.g., the trunk lid, of the vehicle panels, e.g., the rear panels, is in the closed position, the hinge, the latch, and the lock are hidden and not visible, and the lock assembly is also hidden therebehind and hidden behind an escutcheon and decorative cover as is conventional and is not visible; and therefore the external appearance of the vehicle is not substantially altered.

As to Sisler, Ogilvie, 1966, and LeVee, the differences in the claimed subject matter are clearly taught and suggested in

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the prior art and thus would have been obvious. Applicants' arguments against the various elements thereof, e.g., element 21 of Sisler not being a storage box, element 110 of Ogilvie, 1966, not being a strut assembly, element 60 of LeVee not being drain/air relief valve assembly, etc., fail to correspond to the claim terminology which do not so limit but merely recite, e.g., "strut assembly" upon which the particular disclosure of Ogilvie, 1966, direct reads (see column 3, lines 71-75, "a foldable support 110 ... for supporting the ... cover 96 in the open position"); and limitations from a pending application's specification will not be read into claims which lack explicit recitation of those limitations in support of patentability (see *Sjolund v. Musland*, 847 F.2d 1573, 6 USPQ2d 2020 (Fed. Cir. 1988); *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982)).

Finally, Applicants argue that factors of nonobviousness of commercial success and competitor copying weight against the 35 U.S.C. § 103 rejections. While any factor of nonobviousness necessarily weighs against a § 103 rejection, and may even tip a claim in favor of allowance, a single factor is not dispositive. Further, Applicants have failed to submit any sworn affidavits under 37 C.F.R. § 132 in regard thereto. Applicants submit a brochure, which is insufficient; the brochure does not show all of the claimed features of all of the embodiments but only shows

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one pickup truck, and only a single claim, claim 48, is particularly directed toward a pickup.

Regarding the objections to the specification and the drawings, by Applicants' own disclosure there are different embodiments and different features thereof. For the example, the storage box 103 for the alternative embodiment shown in Fig. 10 is disclosed on page 16 as may only extending the length of section 101'. Also, the mountings (e.g., holes) for the hinges in box 103 shown in Fig. 9 are located adjacent the upper and lower edges of the opening of the box, while the mountings for the hinges in box 103 shown in Fig. 10 are only located adjacent the upper edge. Therefore, the drawings fail to comply with 37 C.F.R. § 1.84(p)(4), and the specification fails to comply with 37 C.F.R. § 1.74 with respect to 37 C.F.R. § 1.84(p)(4), as failing to identify the parts of the different embodiments by unique reference numerals.

#### **Conclusion**

28. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Andrew Pike whose telephone number is (703) 308-3423.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Correspondence related to this application may be transmitted by facsimile in accordance with 37 C.F.R. § 1.6, except for that correspondence for which facsimile transmission



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is prohibited under 37 C.F.R. § 1.6(d). Facsimile copies of an original signature under 37 C.F.R. § 1.4(d)(2) on correspondence transmitted by facsimile under 37 C.F.R. § 1.6 are acceptable. Applicants should retain the original correspondence papers as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original correspondence papers; BUT APPLICANTS SHOULD **NOT** SUBMIT THE ORIGINAL CORRESPONDENCE PAPERS IN ADDITION TO THAT TRANSMITTED BY FACSIMILE unless specifically required to by the Office. The Technology Center 3600 Fax Center facsimile number is (703) 305-7687.

*Andrew C. Pike*  
5-26-1999  
ANDREW C. PIKE  
PRIMARY EXAMINER  
ART UNIT 3651

acp  
May 26, 1999

The interference prints are located above the drawing prints on the right-hand portion of the file wrapper when initially received in the examining group.

After the application has been classified and assigned to an examiner, the interference prints should be removed and placed in the drawing cabinets.

If an application has several sheets of drawings, the interference prints should be stapled together at their bottom edges before being filed. If the number of sheets of prints is too large to be stapled, a fastener should be placed through the holes at the top.

The time when the interference prints are removed from the drawing cabinets is determined by the Group Director.

The drawings filed by applicant remain in the file wrapper.

### 608.02(n) Duplicate Prints in Patentability Report Cases

In patentability report cases having drawings, the examiner to whom the case is assigned should normally obtain a duplicate set of the interference prints of the drawing for filing in the group to which the case is referred.

When a case that has had patentability report prosecution is passed for issue or becomes abandoned, notification of this fact is given by the group having jurisdiction of the case to each group that submitted a patentability report. The examiner of each such reporting group notes the date of allowance or abandonment on his or her duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

For patentability reports, see MPEP § 705 to § 705.01(f).

### 608.02(o) Dates Entered on Drawing

The Mail Center (Office Date) stamp and the "Corrected" stamp applied by the Drafting Review Branch are impressed on the back of the drawings. If the drawings are filed in the examining group, the group date of receipt stamp should be applied to the back of the drawing near the top.

Approval by the Drafting Review Branch is indicated by a legend associated with the "O.G. Fig. Cl. . . . Sub. . . ." stamp on the front of each sheet.

### 608.02(p) Correction of Drawings

#### 37 CFR 1.121. Manner of making amendments

(a) *Amendments in nonprovisional applications, other than reissue applications:* Amendments in nonprovisional applications, excluding reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

\*\*\*\*\*

#### (3) Drawings.

(i) Amendments to the original application drawings are not permitted. Any change to the application drawings must be by way of a substitute sheet of drawings for each sheet changed submitted in compliance with § 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

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For corrections which are deferrable, see MPEP § 608.02(b). For correction at allowance and issue, see MPEP § 608.02(w) and MPEP § 1302.05.

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description of the view if a canceled figure is reinstated.

### 608.02(q) Conditions Precedent to Amendment of Drawing

No alterations will be permitted unless required by an examiner's letter in each case or proposed in writing by applicant or his or her attorney or agent. In either case, the alterations or corrections as indicated in the sketches filed with the request of the applicant or his or her attorney or agent must be given written approval by the examiner before the drawing is corrected.

#### CORRECTION OF INFORMALITIES (DRAFTSPERSON'S OBJECTIONS ON PTO-948)

Form Paragraph 6.40 (reproduced in MPEP § 608.02), the back page of PTO-948, and the back page of PTOL-37, the "Notice of Allowability," provide detailed information on how to effect drawing changes.

In order to correct any informalities in the drawings, applicants *MUST* comply with the requirements set forth below. Failure to do so will result in *ABANDONMENT* of the application.

File new drawings with the changes incorporated therein. Applicant may delay filing of the new drawings until the application is allowed by the examiner. If delayed, the new drawings *MUST* be filed within the pe-